

REMARKS

Claims 19-27 and 32-33 are currently pending in the present application, of which claims 19 and 32 are independent. Claims 1-11 were previously cancelled and claims 12-18, 28-31, and 34-26 have been withdrawn without prejudice. Claims 19-27 and 32-33 have been rejected.

The Examiner asserts that the reply filed on November 10, 2008 was not fully responsive to the Office Action mailed on July 9, 2008 and requests additional information. Specifically, the Examiner requests “further clarification concerning the matrix in claim 19, wherein the phaco power levels and fluid flow conditions ‘will not generate sufficient heat to create damage to tissue within the eye.’” Office Action mailed on March 4, 2009, p. 2 second paragraph. The Examiner has indicated that “distinguishing this invention with the prior art of record on the basis of the negative limitation cited above without pointing out its specific support in the specification provides a very weak argument since the prior art had to meet the requirements of Section 101.” Id. The Examiner requests specific references to the specification to “ensure that the comparisons to the prior art presented by the applicant are in fact adequate.” Id. at paragraph 4.

Without acquiescing to the Examiner’s characterization, but in furtherance of prosecution, the Applicant provides the following information. Throughout the specification the limitation “will not generate sufficient heat to create damage to tissue within the eye” is discussed. Specifically, page 2, line 34 – page 3, line 10 states:

However, of further consideration regarding the utilization of phacoemulsification handpiece, is the amount of power delivered to the lens by the handpiece in order to fragment the lens. If too much power is delivered to the handpiece, without concomitant fluid or cooling irrigation fluid, local temperatures of the eye may rise to a level causing localized trauma. On the hand, the entire eye may be heated during the procedure within the anterior chamber which may cause damage. Thus, it is important to not only control the power delivery of a phacoemulsification handpiece, but to provide a means for calculating elevated anterior chamber temperatures in order to prevent any tissue damage due to excess delivered power. Such damage can occur within one to two seconds under adverse heating conditions.

The limitation is further discussed at page 4, lines 3-8:

In connection therewith, a computer responsive to input from the means for monitoring power provided and removed, provides a means for calculating an energy balance over a time interval and determining a matrix of power levels and duty cycle combination that will not generate sufficient heat to create a burn of eye tissue. The power may then be regulated in accordance with the matrix.

Additionally, the limitation is discussed at page 4, line 32 to page 5, line 6:

Correspondingly, a method for regulating fluid flow and power to an ultrasonic phacoemulsification, or cataract extraction, handpiece, includes the steps of monitoring power provided to the handpiece, monitoring power removed from the eye by the aspirated fluid and calculating, in response to input from the steps of monitoring the power provided and the power removed, a matrix of power levels and duty cycle combinations that will not generate sufficient heat to create a burn in eye tissue. The matrix can then be used to prevent operation of the handpiece outside the matrix or alert a surgeon of potential burns if the handpiece is operated outside the matrix.

Applicant would also like to point out that support for the limitation can be found in Figure 2 and in claims 1, 3, 5, 7, 8, 9, and 10 as originally filed.

Therefore, based upon the foregoing, the negative limitation of “will not generate sufficient heat to create damage to tissue within the eye” is supported by the specification as required by MPEP §2163 - §2163.07(b) and §2173.05(i) and provides a strong argument of novelty and non-obviousness over the prior art of record. The limitation, *inter alia*, is not taught or suggested by the prior art of record, namely Parisi, Scheller, and Tu. Based upon the totality of the foregoing and the response filed on November 10, 2008, which is hereby incorporated by reference, Applicant respectfully submits that claims 19 and 32 are allowable over the references of record, as well as the claims that depend therefrom.

CONCLUSION

It is respectfully submitted that all claims of the present application are in condition for allowance. Consideration and allowance of all pending claims at an early date is respectfully requested.

Should any additional fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 502317. Should the Examiner have any questions or concerns, please do not hesitate to contact the undersigning attorney at 714-247-8422.

Respectfully submitted,

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